

REMARKS

Claims 1-7 are pending in this application. Claims 1, 4, and 5 have been rejected. Claims 2, 3, 6, and 7 have been objected to as being dependent upon a rejected base claim. By this Amendment, Claims 1, 4, and 5 have been amended and new Claims 8-9 have been added. No new matter has been added.

Claim 1 has been rejected under 35 U.S.C. 112, first paragraph, as not sufficiently described in the specification to enable one of ordinary skill how to make and/or use the claimed invention. It is noted that this rejection rests upon the recitation of "the residue of a saturated heterocyclic ring having 5 or 6 atoms" in the language of Claim 1. Claim 1 has been amended to delete "the residue of." It is submitted that this amendment has removed any confusion in the claim language and it is requested that the rejection of Claim 1 be withdrawn for this reason.

Additionally, it is submitted that the claim, regardless of whether "the residue of" is included in the claim language, is enabled. The Examiner has taken the position that the specification does not give any guidance as to how to prepare (nitrooxymethyl)phenyl ester compounds having a saturated heterocyclic ring having 5 to 6 atoms). It is submitted that the present invention is formed by reacting the acyl halide of the salicylic acid compound with hydroxybenzyl alcohol and an addition of nitric acid, thereby forming the nitroxy derivative. It is further submitted that methods of manufacturing these types of compounds are known in the art. Therefore, because MPEP section 2164.05(a) states that the "specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those

skilled and already available to the public,” it is submitted that a teaching of these processes in the specification is not necessary.

Additionally, attached to this Response is a copy of U.S. Patent No. 6,512,137 in which identical claim language is used. It is submitted that the attached patent demonstrates that the claim language is acceptable and it is requested that the rejection be withdrawn for these reasons as well.

Claims 1, 4, and 5 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claim 1 has been rejected for reciting “the residue of a saturated heterocyclic ring having 5 or 6 atoms.” It is submitted that the above discussed removal of “the residue of” is sufficient to address this rejection as well. Therefore, it is requested that this basis for the indefiniteness rejection be withdrawn.

Claim 1 has also been rejected as indefinite because it recites “preferably the position is the meta one.” This language has been removed from Claim 1. Therefore, it is requested that the rejection be withdrawn.

Finally, Claim 1 has also been rejected for reciting “preferably R₁ is acetoxy” and “preferably R₂ is hydrogen.” The Examiner’s suggestion that this language be removed from the claim and added in a new dependent claim has been adopted. Therefore, it is requested that these rejections be withdrawn as well.

Claim 4 has been rejected for reciting “preferably between 1.2 and 1.5.” The Examiner’s suggestion that this language be removed from Claim 4 and added as a new dependent claim has been adopted. It is requested that this rejection be withdrawn in view of the amendments made to Claim 4.

Claim 5 has been rejected for reciting "preferably between 1 and 3." This language has been removed from Claim 5. Therefore, it is requested that the rejection be withdrawn.

In the event this paper is not timely filed, the Applicants respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 01-2300 making reference to Attorney Docket No. 108907-00024.

In the event that there are any fees due with respect to the filing of this paper, please charge Deposit Account No. 01-2300, referring to client-matter number 108907-00024.

Respectfully submitted,



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Enclosure: U.S. Patent No. 6,512,137
Request for Small Entity Status
Request for Refund